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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,595	01/16/2004	Katsukuni Nitta	NITTAI	5392
1444 7590 04/14/2009 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303				
EXAMINER				
FERGUSON, LAWRENCE D				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
04/14/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/758,595

**Applicant(s)**

NITTA ET AL.

**Examiner**

Lawrence D. Ferguson

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1.4.6 and 8-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1.4.6 and 8-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 3/13/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to the amendment filed January 5, 2009.

Claims 1, 9 and 12 were amended and claims 2-3, 5 and 7 were cancelled rendering claims 1, 4, 6 and 8-28 pending.

***Claim Rejections – 35 USC § 102(b)***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4, 6 and 8-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi et al (U.S. 6,013,363).

Takahashi discloses a microporous thermoplastic resin film comprising thermoplastic resin films provided on both sides of a core layer (column 2, lines 54-65) where a black solid print layer having a thickness of 1 $\mu$ m to 5 $\mu$ m is formed on the back of the microporous resin film by offset or gravure printing to form an opacifying layer (light shielding layer) (column 8, lines 54-65) which comprises the thermoplastic resin films.

Applicant defines a light shielding layer as being formed by a color print layer such as a black solid print layer having a thickness of from 1 to 5 micrometers on the back face of a thermoplastic resin film in a mode of offset printing or gravure printing, where a dot ratio of the print is varied to fall between 5 and 70%, the total transmittance through the light part of the film is preferably from 5 to 12 percent and the dark part may be at least 90% and the light part may be at most 10% (paragraphs 0060-0064 of the instant specification) which renders the black solid print layer having a thickness of 1  $\mu\text{m}$  to 5  $\mu\text{m}$  which is formed on the back of the thermoplastic microporous resin film of Takahashi as being a light shielding layer having a dot ratio of from 5 to 70 percent, a total light transmittance through the light part of the shaded area as being from 5 to 12 percent and the proportion of the dark part of the shaded area is at least 90 percent and that of the light part is at most 10 percent.

Because Takahashi discloses a light shielding layer with a thermoplastic resin film on both sides of the light shielding layer formed by offset or gravure printing, it is inherent for the layer to be shaded, which is invisible by reflected light and visible by transmitting light. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of a newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. Additionally, anticipation by a prior art reference does not require that the reference recognize the

inherent properties that may be possessed by the prior art reference. See *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633 (Fed. Cir.) (1987), as in claims 1, 4, 6, 9.

In claim 1, the phrase, "for forgery prevention" is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Concerning claim 8, the total light transmittance of the material is 0 percent (column 8 ,lines 54-65).

Concerning claim 10, the print layer can comprise titanium oxide (column 8, lines 54-65) where the titanium is considered to be a magnetic material.

Concerning claim 11, the light shielding layer can be formed by applying from 2 to 10g/m<sup>2</sup> of an adhesive that contains from 5 to 75 weight percent of white filler (column 8, lines 54-65).

Concerning claim 12, vapor deposited aluminum can be applied to one of the thermoplastic films (column 5, line 63 through column 6, line 4).

Concerning claims 13-14, the thermoplastic film has a multilayer structure where an additional thermoplastic layer can be laminated on the surface of the first thermoplastic layer (column 2, line 45 through column 3, line 6).

Concerning claims 15-16, the thermoplastic resins used in the invention can be polyethylene terephthalate (column 4, lines 21-25).

Concerning claims 17-18, the outermost surface of the thermoplastic film is printed (column 2, lines 1-9) where it is inherent for the toner to be either dry or liquid, which is applied to the outermost surface.

Concerning claim 19, the film can be laminated with an additional heat sealable layer (column 4, lines 62-67).

Concerning claim 20, a material (column 1, lines 4-7) comprises the film of claim 1.

Concerning claims 21-28, Takahashi shows a laminated sheet or structure (Figure 2) which is interpreted as having the form of a card, security, certificate, bill, ticket, check, license or label.

In all of the above mentioned claims, the instant invention includes the preamble language of, "a forgery-preventing film". Although the instant preamble has been considered, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the preamble merely recites the intended use of a structure, and the body of the claim is able to stand alone; therefore, although the

preamble has been considered, the preamble language has not been accorded patentable weight.

### **Response to Arguments**

4. The rejection made under 35 U.S.C. 112, second paragraph, is withdrawn due to Applicant amending claims 9 and 12 to particularly point out and distinctly claim the subject matter which applicant regards as the invention

The rejection made under 35 U.S.C. 102(b) as being anticipated by Akao (U.S. 4,469,741) is withdrawn due to Applicant amending claim 1 to include the limitations of cancelled claim 5, which was not met by the rejection.

The rejection made under 35 U.S.C. 103(a) as being unpatentable over Akao (U.S. 4,469,741) is withdrawn due to the reference not meeting the limitation of a forgery-preventing area having a dot ratio of from 5 to 70 percent.

The rejection made under 35 U.S.C. 102(b) as being anticipated by Akao (U.S. 4,653,640) is withdrawn due to Applicant amending claim 1 to include the limitations of cancelled claim 5, which was not met by the rejection.

The rejection made under 35 U.S.C. 103(a) as being unpatentable over Akao (U.S. 4,653,640) is withdrawn due to the reference not meeting the limitation of a forgery-preventing area having a dot ratio of from 5 to 70 percent.

The rejection made under 35 U.S.C. 102(b) as being anticipated by Akao (U.S. 4,661,401) is withdrawn due to Applicant amending claim 1 to include the limitations of cancelled claim 5, which was not met by the rejection.

The rejection made under 35 U.S.C. 103(a) as being unpatentable over Akao (U.S. 4,661,401) is withdrawn due to the reference not meeting the limitation of a forgery-preventing area having a dot ratio of from 5 to 70 percent.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample, can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.



Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Lawrence Ferguson/  
Patent Examiner, Art Unit 1794

/David R. Sample/  
Supervisory Patent Examiner, Art Unit 1794